IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Joakim Bergstrom, *et al.*	§	Group Art Unit:	2416
Application No.	10/595,288	§	Examiner:	Jiang, Charles C.
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APPEAL BRIEF SUBMITTED UNDER 35 U.S.C. §134

This Appeal Brief is submitted to appeal the decision of the Primary Examiner, set forth in Final Official Action dated July 23, 2009, finally rejecting claims 8, 10 and 12-14, and the Advisory Action, dated September 29, 2009, maintaining the claim rejections.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §41.20(b)(2), and to credit any overpayment, to Deposit Account No. 50-1379.

Real Party in Interest

The real party in interest, by assignment, is: Telefonaktiebolaget LM Ericsson (publ)
SE-164 83
Stockholm, Sweden

Related Appeals and Interferences

None.

Status of Claims

Claims 1-7, 9 and 11 were previously cancelled and are not appealed. Claims 8, 10 and 12-14 remain pending, each of which are finally rejected and form the basis for this appeal. A copy of claims 8, 10 and 12-14, as amended to date, are submitted herewith in the Claims Appendix.

Status of Amendments

The claims set out in the Claims Appendix include all entered amendments. No amendment has been filed subsequent to the final rejection.

Summary of Claimed Subject Matter

Claim 8	Specification Reference
8. A method for avoiding collisions on a random access channel of a telecommunication system providing Multimedia Broadcast/Multicast Services (MBMS) to a plurality of subscribing user equipments, said method comprising the steps of:	Page 5, line 27, *et seq.*
dividing an MBMS session into a first period for transmission of MBMS data to user equipments and a subsequent second period for receiving feedback information, by determining a delay time period for each subscribing user equipment after the lapse of which said user equipment starts transmission of feedback information on the random access channel for acknowledgement of successfully received MBMS data portions; and	Page 6, line 13, *et seq.* Page 9, line 20, *et seq.*
selecting a preamble signature for use on a sub-channel of a random access channel for the subscribing user equipments; then,	Page 9, line 27, *et seq.*
forwarding said respective delay time periods and preamble signature to the user equipments; then	Page 9, line 28, *et seq.*
transmitting one or more MBMS data	Page 10, line 1, *et seq.*

portions on a downlink channel to the group of subscribing user equipments; and	
receiving feedback information from the plurality of user equipments.	Page 10, line 3, *et seq.*

Claim 10	**Specification Reference**
10. A method in a user equipment of a telecommunication system subscribing to a Multimedia Broadcast/Multicast Service (MBMS), said method comprising the steps of:	Page 5, line 27, *et seq.*
determining a delay time period based on dividing an MBMS session into a first period for transmission of MBMS data to the user equipment and a subsequent second period for transmitting feedback information by the user equipment;	Page 8, line 16, *et seq.*
using a preamble signature on a sub-channel of a random access channel for transmission of said feedback information by the user equipment; and	Page 9, line 8, *et seq.*
transmitting by the user equipment, after the lapse of said delay time period, feedback information on the random access channel using the preamble signature for acknowledgement of successfully received MBMS-data portions.	Page 9, line 5, *et seq.*

Grounds of Rejection to be Reviewed on Appeal

1.) Whether claims 8 and 13-14 are unpatentable, under 35 U.S. C. §103(a), over Chuah I (U.S. Patent Publication No. 2004/0032877) in view of Willekes (U.S. Patent Publication No.2002/0075824) and Chuah II (U.S. Patent No. 6,674,765);

2.) Whether claim 10 is unpatentable, under 35 U.S. C. §103(a), over Chuah II in view of Willekes; and,

3.) Whether claim 12 is unpatentable, under 35 U.S. C. §103(a), over Chuah I in view of Willekes, Chuah II and Osawa (U.S. Patent No. 5,621,732).

Arguments

1.) Claims 8 and 13-14 are patentable over Chuah I in view of Willekes and Chuah II

The Examiner rejected claims 8 and 13-14 as being unpatentable over Chuah I (U.S. Patent Publication No. 2004/0032877) in view of Willekes (U.S. Patent Publication No.2002/0075824) and Chuah II (U.S. Patent No. 6,674,765). In rejecting claim 8, the Examiner acknowledged that Chuah I and Willekes fail to teach selecting a preamble signature for use on a sub-channel of a random access channel for subscribing user equipments. To overcome that deficiency, the Examiner looks to the teachings of Chuah II, asserting that it teaches:

> "selecting a preamble signature for use on a sub-channel of a random access channel for the subscribing user equipments (Chuah, USPN 6,674,765, Fig. 8, Element 804, Col. 12, Lines 37-50, Chuah ('765) directed toward use of a sub-channel of a random access channel, see Col 6, Lines 55-67)"

The undersigned has reviewed the referenced portions of Chuah II, however, and does not see what the Examiner asserts is taught at the referenced locations. Although element 804 in Figure 8 illustrates and is described as a step of selecting a preamble, there is no teaching at column 6, lines 55-67, of selecting a preamble signature "for use on a sub-channel of a random access channel for subscribing user equipments," as recited in claim 8. Therefore, the Examiner has not established a *prima facie* case of obviousness for that claim. Thus, whereas claims 12-14 are dependent from claim 8, and include the limitations thereof, they are also not obvious in view of Chuah I, Willekes and Chuah II.

In the Advisory Action, in response to Applicants' argument that the referenced portion of Chuah II fails to disclose the foregoing claim limitation, the Examiner merely asserts that:

> "a recitation of the intended use of the claimed invention must result ina structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

> In addition, Chuah [II] teaches [the] limitation . . . The invention of Chuah [II] is directed towards random access channel optimization in a multi subscriber environment. Thus, the applicant's arguments with respect to [claim 8 is] not persuasive."

The Examiner misstates both the law and the particulars of the claimed invention. The limitation of "for use on a sub-channel of a random access channel for the subscribing user equipments" is tied to "selecting a preamble signature." Furthermore, once such preamble signature for use on a sub-channel of a random access channel for subscribing user equipments is selected, it is forwarded, along with a delay time periods determined in a prior step, to the user equipments. The combination of those functions, and others, in claim 8, is for the purpose of avoiding collisions on a random access channel of a telecommunication system providing MBMS services to a plurality of subscribing user equipments. The Examiner has not pointed to any such purpose in the individual references, nor in the combination thereof. The Examiner is merely picking and choosing similar or identical technical elements from the cited references, without any regard to the functions performed by those elements, either individually or in combination. Thus, the Examiner has not established a *prima facie* case of obviousness of claim 8. Whereas claims 12-14 are dependent from claim 8, and include the limitations thereof, they are also not obvious in view of the cited references.

2.) Claim 10 is patentableover Chuah II in view of Willekes

As established *supra* with respect to claim 8, there is no teaching in Chuah II of selecting a preamble signature "for use on a sub-channel of a random access channel for subscribing user equipments," as also recited in claim 10. The Examiner has not pointed to any teaching in Willekes to overcome that deficiency. Therefore, the Examiner has not established a *prima facie* case of obviousness for claim 10 in view of Chuah II and Willekes.

3.) Claim 12 is patentable over Chuah I in view of Willekes, Chuah II and Osawa

As established *supra* with respect to claim 8, there is no teaching in Chuah II of selecting a preamble signature "for use on a sub-channel of a random access channel for subscribing user equipments." The Examiner has not pointed to any teaching in Willekes, Chuah or Osawa to overcome that deficiency. Therefore, the Examiner has not established a *prima facie* case of obviousness for claim 12 in view of the combination of references.

CONCLUSION

The claims currently pending in the application are patentable over the cited references and the Applicants request that the Examiner's claim rejections be reversed and the application be remanded for further prosecution.

Respectfully submitted,

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CLAIMS APPENDIX

1-7. (Cancelled)

8. (Previously Presented) A method for avoiding collisions on a random access channel of a telecommunication system providing Multimedia Broadcast/Multicast Services (MBMS) to a plurality of subscribing user equipments, said method comprising the steps of:

dividing an MBMS session into a first period for transmission of MBMS data to user equipments and a subsequent second period for receiving feedback information, by determining a delay time period for each subscribing user equipment after the lapse of which said user equipment starts transmission of feedback information on the random access channel for acknowledgement of successfully received MBMS data portions; and

selecting a preamble signature for use on a sub-channel of a random access channel for the subscribing user equipments; then,

forwarding said respective delay time periods and preamble signature to the user equipments; then

transmitting one or more MBMS data portions on a downlink channel to the group of subscribing user equipments; and

receiving feedback information from the plurality of user equipments.

9. (Canceled)

10. (Previously Presented) A method in a user equipment of a telecommunication system subscribing to a Multimedia Broadcast/Multicast Service (MBMS), said method comprising the steps of:

determining a delay time period based on dividing an MBMS session into a first period for transmission of MBMS data to the user equipment and a subsequent second period for transmitting feedback information by the user equipment;

using a preamble signature on a sub-channel of a random access channel for transmission of said feedback information by the user equipment; and

transmitting by the user equipment, after the lapse of said delay time period, feedback information on the random access channel using the preamble signature for acknowledgement of successfully received MBMS-data portions.

11. (Canceled)

12. (Previously Presented) The method according to claim 8, wherein said delay time period starts counting at a user equipment from the successful reception of said one or more MBMS-data portions.

13. (Previously Presented) The method according to claim 8, wherein said delay time period is calculated from a unique identifier of the user equipment.

14. (Previously Presented) The method according to claim 8, wherein said delay time period constitutes a randomly determined value within a given time period.

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EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.